

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 7 was objected to as being improperly dependent upon claim 8. In response, Applicants have corrected the dependency of claim 7 to claim 6.

Claims 1, 3-13, 25-27 and 36 were rejected under 35 USC § 103(a) as being obvious over Cuny et al. ("Cuny"), US 6,677,332, in view of Yamamoto et al. ("Yamamoto"), US 6,642,257. In response, Applicants respectfully request reconsideration and withdrawal of this rejection. In particular, Applicants respectfully submit that the cited combination of references does not make out a *prima facie* case of the obviousness of the instant claims.

According to the Examiner, it has long been established that position isomerism, in and of itself, gives rise to a *prima facie* case of obviousness. In response, Applicants concede that in many cases *prima facie* obviousness has been found where the claimed compounds and the prior art compounds were related as position isomers. However, Applicants remind the Examiner that there are no per se rules on the subject and that each case must be determined on its own merits. *See, In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985) ("**[G]eneralization** should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other.")

Thus, the burden remains on the Examiner to prove by the citation of evidence that persons skilled in the art would have been motivated to make the modifications necessary to

convert the prior art compounds to the claimed compounds. Applicants respectfully submit that the Examiner has not discharged this burden in this instance.

First, the Examiner concedes that the Cuny compounds are all 3-position substituted compounds whereas the Yamamoto compounds are structurally different than the Cuny compounds and, moreover, are all 4-position substituted compounds. The fact that 3-position compounds and structurally different 4-position compounds exist does not establish the general equivalence of the 3- and 4-positions. Equivalence could only be established by a reference that in the same type of compounds teaches substitution at both positions. Since Yamamoto does not do that, Yamamoto does not prove the motivation of persons skilled in the art to modify Cuny's 3-position substituent to the 4-position. In the absence of evidence of such motivation, the Examiner has not made out a *prima facie* case of obviousness.

Second, Yamamoto's structure is specialized and is taught by Yamamoto to provide utilities that are not even held by other 4-hydroxypiperidines. See, for example, Yamamoto at column 2, line 58, through column 3, line 7. Yamamoto clearly teaches that his compounds are "distinct" from such 4-hydroxypiperidines. The Cuny compounds are not even as close to Yamamoto's compounds as are the 4-hydroxypiperidines. Accordingly, persons skilled in the art would rightly view Cuny's compounds as very remote structurally from Yamamoto's compounds. Accordingly, such persons would not have been motivated by Yamamoto's teachings to make 4-position analogs of Cuny's compounds. Therefore, once again, the combination of Cuny and Yamamoto fails to make out a *prima facie* case of the obviousness of the instant claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants also request that the Examiner give special consideration to new claims 37 and 38. The compounds of these claims lack the $-NR_1-COR_2$ structure that is an absolute requirement of Cuny's compounds of Formula A. There is nothing in Yamamoto that bridges the gap between Cuny and these claims. Accordingly, even if the rejection is maintained as to the other claims, which Applicants submit it should not, claims 37 and 38 should still be allowable.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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